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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,325	08/25/2000	Andrew John Holmes	TS7564 (US)	6381

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Kimbley L Muller
c/o Shell Oil Company
Legal Intellectual Property
P O Box 2463
Houston, TX 77252-2463

EXAMINER

JOHNSON, JERRY D

ART UNIT PAPER NUMBER

1764

DATE MAILED: 04/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,325

Applicant(s)

HOLMES ET AL.

Examiner

Jerry D. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Denis et al.

Denis et al., U.S. Patent 4,954,273, teach lubricating oil compositions containing zinc dithiophosphate, overbased magnesium salicylate and an anti-foaming agent (columns 13 and 14, examples I, II, III and V).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denis et al.

Denis et al teach fully formulated crank case oils containing 1) 0.3 to 2 weight percent VI improvers; 2) 0.5 to 3 weight percent zinc dithiophosphates anti-wear agent; 3) about 1 to 15 weight percent nitrogen-containing and/or polyol dispersants; 4) 0.2 to 3 weight percent of an overbased magnesium salicylate (column 12, lines 4-68; column 13, lines 1-21). While Denis et al do not specifically disclose additives of applicants' formula (I) (i.e., polyol dispersants formed by the reaction of a polyol and a high molecular weight alkylated succan as taught in column 12, lines 24-29) or compositions wherein the ratio of magnesium salicylate to zinc dithiophosphate is within the claimed range, it would have been obvious to one having ordinary skill in the art at the time the invention was made to follow the above teachings and arrive at a composition having the claimed components and component amounts.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al in view of European Patent Application 0 434 464 A1 and Karn.

Matthews et al, U.S. Patent 4,462,918, teach lubricating oil compositions, and in particular a lubricating oil composition which may be used as a hydraulic fluid (column 1, lines 5-7). The composition comprises a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I gives improved anti-wear performance (column 1, lines 49-60). Most preferably, the Group II metal dithiophosphate is a zinc dialkyl dithiophosphate of which the alkyl groups contain 3-20 carbon atoms (column 2, lines 7-14). The combination of additives

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may suitably be used with other additives (column 2, lines 38-42). While Matthews et al teach the addition of other additives, Matthews et al differ from the instant claims in not teaching the addition of a magnesium salicylate.

European Patent Application 0 434 464 A1 (hereafter EPA '464) teach lubricant compositions especially useful as hydraulic fluids containing an amino succinate ester as corrosion inhibitor (abstract). EPA '464 teach that when used in an acidic environment, it can be desirable to incorporate, inter alia, overbased alkylsalicylate (page 3, lines 49-52).

Karn, U.S. Patent 4,627,928, is relied on as teaching overbased magnesium alkylsalicylates as additives for hydraulic fluids (column 17, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the overbased magnesium alkylsalicylate of Karn to the lubricating composition of Matthews et al as taught by EPA '464 and because Matthews et al specifically teach that other additives may be incorporated into the composition of their invention.

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fujitsu et al.

Fujitsu et al, U.S. Patent 6,114,288, teach lubricating oil compositions comprising a zinc dialkyldithiophosphate and a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate (abstract). In Tables 2 and 3 of Fujitsu et al, lubricating compositions comprising magnesium salicylate, zinc dialkyldithiophosphate, defoaming agent and pour point depressant are disclosed.

Claims 2-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujitsu et al as applied to claims 1 and 5 above, and further in view of Matthews et al.

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In column 5, lines 13-15, Fujitsu et al specifically teach the addition of alkenyl succinic acid or ester moieties thereof as rust preventing additives for their lubricating compositions.

Matthews et al, U.S. Patent 4,462,918, teach lubricating oil compositions comprising a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I used as anti-rust agents in lubricating oil compositions gives improved anti-wear performance (column 1, lines 49-60). The combination of additives may suitably be used with other additives (column 2, lines 38-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to a compound of formula I as taught by Matthews et al to the lubricating composition of Fujitsu et al because Fujitsu et al specifically teach the addition of such compounds. Additionally, one having ordinary skill in the art would have been motivated by the desire to increase the anti-wear performance of the lubricating composition as taught by Matthews et al.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 lacks antecedent basis to refer to "formula I" (line 3 of the claim).

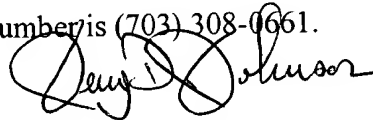
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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
March 28, 2002